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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,152	09/13/2000	RIE SUZUKI	35.G2067D	2716

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EXAMINER

BOAKYE, ALEXANDER O

ART UNIT	PAPER NUMBER
2667	8

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/661,152	SUZUKI, RIE
	Examiner Alexander Boakye	Art Unit 2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 September 2000.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 31-38 is/are allowed.
 6) Claim(s) 1-28 is/are rejected.
 7) Claim(s) 29 and 30 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2,5-7</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 20, 30, 35, 36, 37 and 38 of U.S. Patent No. 6,285,666. Although the conflicting claims are not identical, they are not patentably distinct from each other because both application claim dividing a communication period for a spread spectrum signal into a plurality of data-communication periods; providing an adjusting period between one data-communication period and other data-communication period, such that the spread spectrum signal is continuously communicated by communicating an adjustment signal for adjusting reception of the spread spectrum signal during the adjustment period; data communication means for communicating spread spectrum data in a plurality of divided data-communication periods with the only difference between the claims of the instant

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invention and the claims of the patent being that the claimed invention in the instant application is fully disclosed in the patent and it is broader than the claimed invention in the patent No. 6,285,666.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 21 (lines 7-9) the limitation "in processing an immediately-following one of the sets of data" is not supported by the specification in such a way as to enable one skilled in the art to make and/ or use the invention.

The same problem of claim 26 appears in claim 26 (lines 7-9).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takai (US Patent # 5,978,412) in view of Ostman (US Patent # 5,590,160).

Regarding claims 26 and 27, Takai discloses a spread spectrum communication apparatus comprising: data transmission means (column 5, lines 43-46) for transmitting data on a spread spectrum signal (column 5, lines 43-46) such that the spread spectrum signal is continuously transmitted (column 5, lines 43-47). Takai differs from the claimed invention in that Takai does not teach information transmission means for transmitting between each two successive sets of data, information to be used by a receiving end in processing an immediately-following one of the sets of data.

However, Ostman teaches information transmission means for transmitting between each two successive sets of data (see Fig. 6b), information to be used by a receiving end in processing an immediately-following one of the sets of data (column 5, line 67-column 6, lines 1-12; the claimed information transmission means corresponds to synch as indicated in Fig. 6b and this is a control signal).

One of ordinary skill in the art would have been motivated to incorporate information transmission means for transmitting between each two successive sets of data, information to be used by a receiving end in processing an immediately-following one of the sets of data into communication network of Takai in order to provide synchronization. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate transmission means for transmitting between each two successive

sets of data, information to be used by a receiving end in processing an immediately-following one of the sets of data such as the one taught by Ostman into communication network of Takai with the motivation being that it provides capability for the system to achieve synchronization, thus enhancing performance.

Regarding claim 28, Takai teaches a spread spectrum communication apparatus (see Fig. 10). Takai does not disclose information transmission means for adjusting gain. However, Ostman teaches information transmission means for adjusting gain (column 6, lines 65-67). One of ordinary skill in the art would have been motivated to incorporate information for adjusting gain into the communication network of Takai in order to provide synchronization. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate information for adjusting gain such as the one taught by Ostman into the communication network of Takai with the motivation being that it provides capability for the system to overcome fading.

Allowable Subject Matter

5. Claims 29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31-34 and 35-38 are allowable.

The following is a statement of reasons for the indication of allowable subject matter: As to claims 31-34 and 35-38, the prior art of record does not teach wherein an adjustment signal for adjusting synchronization is further

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transmitted, in the continuous spread spectrum signal, between one of the plurality of data- communication periods and another one of the plurality of data- communication periods.

6. Claims 1-18 and 21-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, First paragraph, and double patenting rejection set forth in this Office action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Boakye whose telephone number is (703) 308-9554. The examiner can normally be reached on M-F from 8:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703)305-4378. The fax number is (703) 872-9306. Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-4750.

Alexander Boakye

Patent Examiner

AB

5/13/04

CHI PHAM
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5/17/04